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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,365	04/28/2006	David Lind	DC5163 PCT1	5202
137 7590 02/04/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER				
OJURONGBE, OLATUNDE S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/577,365

Applicant(s)

LIND ET AL.

Examiner

OLATUNDE S. OJURONGBE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. The amendments filed on 11/13/2008 have been entered. Claims 1-13 remain pending in the application.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

3. **Claims 1-3 and 5-6**, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gee (US 6,316,541)** in view of **Tamori et al (EP 1172412)**.

The rejections of claims 1-3 and 5-6 remain as set forth in prior office action.

4. **Claims 8-11 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamori et al (EP 1172412)** in view of **Gee (US 6,316,541)**.

The rejections of claims 8-11 and 13 remain as set forth in prior office action.

5. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gee (US 6,316,541)** in view of **Tamori et al (EP 1172412)** as applied to claim 1 above, in further view of **Van Aert et al (EP 1217010)**.

The rejection of claim 4 remains as set forth in prior office action.

6. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gee (US 6,316,541)** in view of **Tamori et al (EP 1172412)** as applied to claim 1 above, as evidenced by **Hyde et al (US 2,891,920)**.

The rejection of claim 7 remains as set forth in prior office action.

7. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamori et al (EP 1172412)** in view of **Gee (US 6,316,541)** as applied to claim 8 above, as evidenced by **Hyde et al (US 2,891,920)**.

The rejection of claim 12 remains as set forth in prior office action.

Response to Arguments

8. Applicants' arguments filed on 11/13/2008 have been fully considered but they are not persuasive.

The applicants argue that Tamori emphasizes the formation of an emulsion (or emulsion particles) containing a silicone-organic polymer (resin) that is primarily an interpenetrating network and that Tamori further emphasizes a method where its siloxane component (A) and vinyl monomer (B) are first combined and reacted as indicated; by contrast, present claims 1 and 8 require first the formation of an emulsion wherein the siloxane component has reacted to form a silicone polymer. Subsequently, claim 1 then describes (ii) adding to the emulsion in (i) components for preparing an emulsion containing an organic polymer by free emulsion polymerization of one or more ethylenically unsaturated organic monomers; and claim 8 describes (ii) preparing a

second emulsion containing an organic polymer by free radical emulsion polymerization of an ethylenically unsaturated organic monomer and combining the first and second emulsions. The examiner disagrees.

In regards to the arguments about claim 1, firstly, the rejection of the present claim is based on the combination of Gee and Tamori, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Furthermore, Tamori teaches the addition of other silicone resins other than component (A) into the dispersion of the invention; such other silicone resins include an aqueous dispersion of polyorganosiloxane [0098]. As pointed out in prior office action, based on the advantages taught by Tamori, it would have been obvious to one of ordinary skill in the art to have incorporated the step of mixing polyorganosiloxane with a radical polymerizable vinyl monomer of Tamori into the method of Gee and as pointed out above, the polyorganosiloxane of Tamori is not limited to component (A) of the invention, as it encompasses other silicone resins other than component (A), which in the case of modified Gee, is the polysiloxane emulsion formed by emulsion polymerization. Hence, modified Gee teaches the formation of an emulsion wherein the siloxane component has reacted to form a silicone polymer and subsequently (ii) of the instant claim.

Regarding the arguments about claim 8, the rejection is based on the combination of Gee and Tamori and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Furthermore, modified Tamori teaches the method of preparing a first emulsion and a second emulsion of the instant claim as pointed out in prior office action.

The applicants further argue that the present invention is directed to the formation of hybrid or alloy emulsions, by contrast, the prior art methods provide emulsions of a single copolymer of a siloxane and an organic acrylate monomer. The examiner disagrees.

Firstly, as pointed out above, the rejections of the claims are based on a combination of references. Furthermore, the examiner notes that whether an emulsion is a hybrid/alloy emulsion or not, is an inherent property of the emulsion, which depends on the reacting components and reacting conditions of producing the emulsion. Since the reacting components and the reacting conditions of modified Gee/modified Tamori all fall within the ranges of those of the instant claims, then the emulsion of modified Gee/modified Tamori is a hybrid or alloy emulsion.

The applicants further argue that the combination of Gee and Tamori fails the teaching/suggestion/motivation to combine test. There is no teaching or suggestion in Gee to add to its emulsions either an emulsion or components for preparing an emulsion. Conversely, starting with Tamori there is no teaching or suggestion to modify its method to prepare an emulsion of a silicone polymer, followed by addition of an emulsion (as per claim 1) containing an organic polymer by free radical emulsion polymerization of one or more ethylenically unsaturated organic monomers. The examiner disagrees.

Regarding claim 1, based upon the advantages taught by Tamori as pointed out in prior office action and as reiterated above, it would have been obvious to one of ordinary skill in the art to have combined the references as stated in prior office action and reiterated above. Moreover, a suggestion or motivation to combine references is an appropriate method for determining obviousness; however it is just one of a number of valid rationales for doing so.

For claim 8, as pointed out in prior office action and reiterated above, Tamori teaches the blending of other emulsions with the dispersion of the invention and based on the advantages of the emulsion of Gee, one of ordinary skill in the art would have combined the emulsion of Gee with that of Tamori et al. Moreover, a suggestion or motivation to combine references is an appropriate method for determining obviousness; however it is just one of a number of valid rationales for doing so.

The applicants further argue that rather, Tamori teaches interpenetrating silicone-organic polymer networks, emphasizing first mixing a siloxane component with an organic component. In this respect, Tamori may be viewed as teaching away from the present process as claimed, thus, applicants believe the rejection fails to establish a prima facie case of obviousness against the claims. The examiner disagrees.

Firstly, the rejections of the present claims are based on the combination of references, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Furthermore, Tamori teaches the addition of other silicone resins other than component (A) to the dispersion of the invention; such other silicone resins include an aqueous dispersion of

polyorganosiloxane [0098]. As pointed out in prior office action, based on the advantages taught by Tamori, it would have been obvious to one of ordinary skill in the art to have incorporated the step of mixing polyorganosiloxane with a radical polymerizable vinyl monomer of Tamori into the method of Gee , and as pointed out above, the polyorganosiloxane of Tamori is not limited to component (A) of the invention, as it encompasses other silicone resins other than component (A), which in the case of modified Gee, is the polysiloxane emulsion formed by emulsion polymerization.

Concerning Tamori teaching interpenetrating silicone-organic polymer network, the examiner notes that the nature of an emulsion formed from a method, is an inherent property of the emulsion, which depends on the reacting components and reacting conditions of producing the emulsion. Since the reacting components and the reacting conditions of modified Gee/modified Tamori all fall within the ranges of those of the instant claims, then the emulsion of modified Gee/modified Tamori exhibits the nature of the emulsion of the instant claims.

The examiner's stance regarding claims 4-13 is as appropriately explained above. The applicants' arguments have failed to put the application in a condition for allowance.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796